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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/806,480 | 03/23/2004 | Claudio Filipponc | | 1700 |

7590 02/06/2007

CLAUDIO FILIPPONE
8708 48TH PLACE
COLLEGE PARK, MD 20740

| EXAMINER | |
|---|---|
| NGUYEN, HOANG M | |
| ART UNIT | PAPER NUMBER |
| 3748 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 02/06/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/806,480 | FILIPPONE, CLAUDIO | |
| | Examiner | Art Unit | |
| | Hoang M. Nguyen | 3748 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *38-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *38-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's amendment dated December 26, 2006, has been fully considered.

Applicant has argued that Striebich does not disclose the mechanical connection between the turbine and the electrical converter. The Examiner strongly disagrees. Striebich discloses a power system for an automobile that inherently has an electric alternator. The waste heat turbine is clearly connected with a stream turbine output shaft 54' (figure 5), then to the internal combustion engine shaft 8 (note figure 1). It's universally known that this engine shaft is connected to an electric alternator. Therefore, it's concluded that Striebich inherently teaches the claimed subject matter.

Applicant has argued the language used by the Examiner is different from the claims. The Examiner disagrees because the missing element here is the clutch control system, and Abdelmalet discloses it's well known to use a clutch control system. Regarding the arguments that it would not have been obvious to combine the references. Once again, the Examiner strongly disagrees because clutch control is well known in the internal combustion engine system, no matter what types of clutch/engine are being used.

The arguments against the obviousness double patenting is also not found persuasive for the same reasons as set forth above, the Examiner maintains his position that it would have been obvious to modify the patents to come up with the

claimed invention because they are all directed to the same field of endeavor and invention: miniaturized waste heat engine.

For the reasons as set forth above, this rejection has been made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4590766 (Striebich).

Striebich discloses an auxiliary power unit for an ICE 1, said auxiliary unit being a waste heat turbine unit 3 being driven by the waste heat from the ICE, gearing mechanism are provided at 9, 10, between the crankshaft 8 and the waste heat turbine. Said waste heat turbine comprising a steam turbine 12 and a condenser having a condensing chamber 13, expander wheel 49 and nozzles 52; on column 4, lines 51-55, Striebich discloses that the gearing 9, 10, may include a free wheel clutch. Regarding the condensed chamber, please note chamber 61 in the primary reference, Striebich, has condensate and can be considered as condensed chamber. Note column 4, lines 6-9, chamber 61 is called a condenser.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 38-50, 54-58, are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 4590766 (Striebich) in view of U.S. 5327987 (Abdelmalek). Striebich discloses all the claimed subject matter as set forth above, but does not disclose a control unit for controlling the engagement of the clutch in response to the speeds of the auxiliary unit and the engine. Abdelmalek is relied upon to disclose it's well known to have a controller 117 in a hybrid engine to control the clutch 101a, 102a, in response to the speeds of an auxiliary unit (electric motor 102) and the main engine (vehicle speed) (note column 6, lines 10-60). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a control unit and speed sensor in Striebich as taught by Abdelmalek for the purpose of controlling the clutch to drive the vehicle more efficiently.

Claims 59, 61, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Striebich in view of Abdelmalek and further in view of Kawamura. Striebich as modified discloses all the claimed subject matter as set forth above in the rejection of claim 38, but does not disclose a flywheel. Kawamura is relied upon to disclose it's well known to use a flywheel 2 in a waste heat system of an engine 1. It would have been obvious

at the time the invention was made to a person having ordinary skill in the art to provide a flywheel in Striebich as taught by Kawamura for the purpose of storing energy.

Claim 60 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Striebich in view of Kawamura. Striebich discloses all the claimed subject matter as set forth above in the rejection of claim 51, but does not disclose a flywheel. Kawamura is relied upon to disclose it's well known to use a flywheel 2 in a waste heat system of an engine 1. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a flywheel in Striebich as taught by Kawamura for the purpose of storing energy.

Claims 37-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6374613, or US patent no. 6729137. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

US 6327613 or US 6729137 anticipates the claimed subject matter of this application. The claims of those patents recite more elements than in this application and therefore the claims of this application should be rejected under obviousness double patenting rejection. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

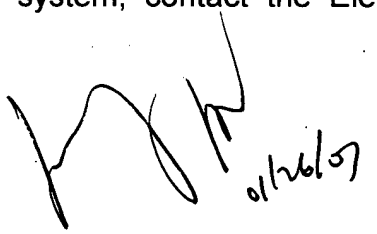
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Nguyen whose telephone number is (571) 272-4861. The examiner can normally be reached on Tuesday--Friday from 12:30 AM to 10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).




HOANG NGUYEN
PRIMARY EXAMINER
ART UNIT 3748

Hoang Minh Nguyen
1/26/2007